

Institut der beim Europäischen
Patentamt zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

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Editorial

T. Johnson (GB)

Some of our readers may remember Dick Fosbury, an American athlete who won the gold medal for the high jump in the 1968 summer Olympics in Mexico City. He achieved this feat by inventing a new technique which became known as the „Fosbury Flop“. This entails jumping so that the bar is under the back of the jumper as he/she attempts to clear it. The „Flop“ raised the heights jumpers could achieve. It truly raised the bar! It is we think, apposite to recall this achievement in our field where new rules concerning search and examination procedures entered into force on 1 April 2010. These are part of the „Raising the Bar“ initiatives at the EPO.

The EPO stresses that raising the bar is not an attempt to raise the threshold for inventiveness, the so-called height of inventive step. Rather, it is said to be about maintaining the quality of patents granted under the EPC. The *epi* is clear that it supports this laudable aim. However, applicants have a right to use the EP system, within the bounds of the Convention, for the benefit of their business. The patent system is indeed part of the armoury of a modern-day business. In exchange for the (limited) monopoly granted via a patent, the applicant discloses the innovation to society. The specification of the patent is published after 18 months from the priority date so society can see what the innovation is about and is not disadvantaged by the period, short or long, during

which an application is pending prior to grant. The new Rules, seems to be designed to make life easier for examiners and to disadvantage an applicant who is perceived by a search examiner to have filed claims that are not clear, either because of the terminology used, or the number of independent claims filed. In this regard, the EPO takes the approach that a European patent application should be drafted to suit the EPO's requirements in each and every respect and does not appear to have sympathy for applicants who need to draft their specifications to suit often contradictory requirements of other patent systems outside the ambit of the EPC. The EPO search examiner will thus issue a search opinion and the applicant is obliged to comment on that opinion before entering the examination stage. This will add cost, as there is an extra layer of communications to contend with and could lead to the applicant being disadvantaged vis-à-vis competitors who will be able to second guess the scope of protection likely to be afforded on grant, as the search reports and responses will be published.

As in all matters, we hope for a balance between the Office and the applicant and make a plea for sensible search opinions which are not onerous on applicants and do not make the bar too high for them. Too high an elevation of the bar could lead to a flop of the system!

Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionssausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **13. August 2010**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of *epi* Information is **13th August 2010**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

Veillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de *epi* Information est le **13 août 2010**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

epi Interview with Dr Christophe Geiger, Associate Professor and Director General, CEIPI Strasbourg 16-17 April 2010

Dr Geiger kindly agreed to meet with the *epi* immediately after the close of the CEIPI conference, „Towards a European Patent Court“ held in Strasbourg on 16 and 17 April 2010.

As with *epi* interviews with other luminaries of the patent world in Europe, a list of questions was drawn up by the editorial committee in conjunction with President Kim Finnilä and was submitted to Dr Geiger in advance of the interview. He told us that he thought the questions posed were well drafted and well thought out and accordingly had no changes to suggest. The questions are set out below; as with other interviews they formed a framework for the interview process.

Dr Geiger has a background in research in IP matters; before taking up his present post he worked for five years in the Max Planck Institute where he was the Head of Department for Francophone countries and researched into IP matters.

CEIPI is a unit within the University of Strasbourg, which is the largest university in France, having about forty thousand students. CEIPI itself has about thirty staff in Strasbourg, and a network of contacts and collaborators in various organisations like the *epi* which provides *inter alia* tutors for CEIPI courses.

The questions posed were:

1. You have been Director General (DG) of CEIPI for about one and one half years. Would you kindly name three of the most important matters that have come up during this time?
2. What are the most important changes in the activities of CEIPI since the change from „industrial property“ to „intellectual property“ (in the name of CEIPI) was made in December 2008?
3. CEIPI was set up in 1963 before the term, „global“ became part of everyday speech. CEIPI works closely with the EPO, the EPA and *epi* and could thus be considered to be a European-oriented body dedicated to strengthening Europe's economic and social position via IP. Do you think this is an accurate perception? How do you see CEIPI's development inside and outside Europe?
4. The EPO is committed to a policy of „raising the bar“. Do you have a view as to what this means in practice? Do the CEIPI courses take this into account, bearing in mind that the EPO seems to consider that the lowering of examination and grant standards is due to the activities of European Patent Attorneys?



Dhillon Photographics

5. Is CEIPI going to expand its offering of IP courses?
6. The *epi* as well as CEIPI, is committed to providing a high quality and highly qualified profession of European Patent Attorneys. How do you think that the two bodies can develop and enhance their cooperation to further this goal?
7. CEIPI assists and coordinates training in quite a number of EPC member states. Have you reflected upon a permanent presence, or some anchormen (tutors) e.g. in the capacity of permanent CEIPI representatives?
8. CEIPI also has close cooperation with WIPO. Do you have plans to develop and enhance this cooperation?
9. You have just successfully completed a high level conference on EEUPC. What are your immediate reflections regarding this conference?
10. Does CEIPI have plans to expand the CEIPI study centre dealing with European court decisions in IP cases, e.g. with regard to collecting, analysing and publishing commentaries on such cases?

Dr Geiger has only been in his post for about one and one half years, but in response to question 1 he was able to identify three areas where CEIPI can be strengthened, and has accordingly initiated actions in all these areas, which are:

- (a) research aspects of IP, teaching needing a strong research element to back it up;
- (b) improving expertise in IP in legislatures; and
- (c) there being strong scepticism of IP in various quarters, CEIPI is developing via research the extension of its activities to copyright and related issues, particularly neighbouring rights such as protection of data bases which are copyright-like rights in order to develop a more horizontal approach in IP matters.

With regard to (a), part of the process has been to hold three conferences, respectively on criminal enforcement, (on which a book is scheduled to be published by CEIPI), Trade Mark law and its future development, particularly covering the interaction of TM law with other areas such as consumer protection, product liability, and the jurisprudence of the ECJ, and the conference „Towards a European Patent Court“ concluded on the day of the interview. (This Court is generally referred to as the EEUPC- European and European Union Patents Court).

There are also monthly lectures on fundamentals of IP by visiting lecturers from the likes of Queen Mary College in London and the Max Planck Institute. These lectures are valuable in assisting cross-fertilisation of ideas as well

as the essential aspect of providing meaningful and interesting lectures as part of the CEIPI curriculum.

Regarding (b), CEIPI provides studies and advice for such bodies as the European Parliament so it can deliberate on the issues of inter alia the European Patent, and the Council of Europe for which body the DG's copyright study has been taken up by the Council.

Strong IP enforcement measures are required in areas such as health issues and organised crime. Issues like the role of IP in the development of green energies also became very relevant. The DG has restructured the CEIPI research team to provide the correct emphasis to deal with all these issues and indeed he has taken the lead in the research effort.

With regard to Question 2, the DG expressed his view that the words „industrial property“ are from, and belong to, the past. „Intellectual Property“ is to be preferred, there being theoretical and practical aspects to be considered in relation to the subject. Theoretically the whole of IP, not just patents, needs to be looked at. There must be a creative, holistic approach to what constitutes IP and its future development. As a practical consequence of this, IP specialists need to broaden their approach to IP, and, with the patent system under pressure as it is, to develop strategies complementary to patents. The profession must not be afraid to embrace change.

With regard to Question 3, the DG answered that CEIPI has traditionally had a European role. However, he is of the view that there must be an emphasis on building a strong, homogeneous European jurisprudence in IP, which hopefully would, and should, include a European Law on copyright. At present the European „model“ of IP is based on decisions of the ECJ, EPO Boards of Appeal, and National jurisprudence. This needs to be developed into a coherent, well-balanced new model. CEIPI is well placed to assist in this development by its research into, and teaching of, IP.

Once this new EU model is in place, Europe should be proactive in promoting it outside Europe. Clearly part of this model is the development of a body of people who understand the system and who can bring awareness of it to others. CEIPI is well-placed to assist in this development of European IP awareness.

Concerning „raising the bar“, Question 4, there could be a difficulty in interpretation, but if as originally proposed, it means an increase in quality of patents and patent applications then this is to be encouraged. However as the granting procedure is a two-way process, the EPO should understand the constraints under which applicants and their representatives often work. The new rules are now in place (as of 1 April, 2010). Hopefully they will be applied in a progressive rather than a proscribing manner. The IP system as a whole would benefit from a progressive approach, which should have a beneficial side-effect of raising awareness and lessening criticism of the system.

Turning to Question 5, whilst CEIPI needs to stabilise what has been built up over the years, it must balance this with moving forward with new courses whilst main-

taining a high quality of training. There are 5 LLM courses which are complex programmes to run, whilst the perspective of the EEUPC will necessarily lead to new demands.

The ultimate CEIPI mission is to build towards a homogeneous EU IP system, wider in scope than being merely patent-based.

With regards to CEIPI/*epi* co-operation, Question 6, there is already extensive *epi* involvement with CEIPI, the two bodies collaborating on basic training of candidates for the EQE. The accession of new countries to the EPC brings new pressures and the basic courses could perhaps be strengthened. The *epi* could assist in this, and could also audit the courses to see if they do need strengthening, whilst also raising awareness of IP and of CEIPI outside Strasbourg. Moreover another field of collaboration could be for the *epi* to consider practical aspects of the research which CEIPI undertakes on IP. There is a sound basis for this, namely the „CEIPI-*epi* course on Patent Litigation in Europe.“ In short, CEIPI values the co-operation and support given by the *epi*.

With regard to Question 7, there could be future scope for permanent „branch“ offices in new countries such as those from former Eastern Europe. Such branch offices could be envisaged to be run by people such as patent attorneys who already have their own practice in a particular country. The mechanics of such a development would need to be worked out, but could for example be based on a franchise operated by CEIPI. The aim would be for branch offices to have a significant role in enhancing awareness of the IP system.

Turning to Question 8 CEIPI has an active and fruitful relationship with WIPO, the DG of that body, Francis Gurry, being Chair of the Administrative Council of CEIPI. Christophe Geiger foresees that CEIPI's research efforts will assist WIPO in its role of international development and to this end has provided or will provide input on Geographical Indications (GIs), international laws on copyright, the WIPO development agenda, sustainable development, and patents on „green“ technology.

On a practical level, there is an annual joint programme (run together with the National Institute of Industrial Property (INPI)) over two weeks when WIPO sends representatives of developing countries to Strasbourg for IP training.

Concerning the EEUPC conference, Question 9, the DG thought it timely and a success. About three hundred delegates attended and the *epi* contributed financially, with speakers, and with its overall support. One of the main messages from the conference was that the system for an EU patent must stay within the EU legal framework as developed by the ECJ, which however would only have a role in interpretation of EU law, and not on questions relating to validity or infringement. The EEUPC would have a wider remit, being proposed to have exclusive jurisdiction over inter alia infringement and validity of European patents, and European Union patents (when the latter are in existence). To enter into force, the EEUPC will be subject to an agreement ratified by European Union Member states and Member states

of the EPC. The EEUPC would in short be a pan-European Court based on an international agreement which would hopefully provide a balanced jurisprudence between the EPO and EU systems as regards infringement and validity.

Finally concerning Question 10, Dr. Geiger foresaw difficulties in setting up a database of court decisions, but does see a role for CEIPI in providing an analysis, perhaps with help from the *epi*, of court decisions. The

aim would be to publish such analyses. This, in Dr. Geiger's view, would add value to the IP system.

On behalf of the *epi*, Kim Finnilä and I thanked Dr. Geiger most sincerely and warmly for agreeing to the interview, particularly as it took place immediately after the conference mentioned above, with which he was so involved as its Convenor.

T. Johnson,
Editorial Committee
Interviewer/reporter

epi Autumn tutorials: EQE 2010 included!

Now EQE candidates who sat current years' EQE are offered an opportunity to have their papers reviewed by an experienced *epi* tutor before taking the next exam (March 2011). The autumn tutorial offers also to re-sit last year's exam (EQE 2009).

The *epi* tutorial is an EQE training event that provides candidates with an opportunity to sit the A/B/C/D papers privately, send the papers to an experienced *epi* tutor assigned to them and have their individual papers reviewed and discussed.

The schedule is as follows:

1. Candidates enrol as soon as possible but not later than September 27, 2010 indicating the papers they want to sit (the registration form can be downloaded from the *epi* website at <http://www.patentepi.com>, section „EQE & Training/Preparation for the EQE“). The enrolment is confirmed by the *epi* secretariat and the candidates are informed about the assigned tutor(s). Two different tutors may be assigned for papers A/B and for papers C/D. A tutor will be assigned to a group of not more than 3 to 5 candidates to allow intensive discussions.
2. In a first round candidates write the papers privately (it is recommended to do so in the time the EQE allows for the particular paper). This years' autumn tutorial will offer the EQE 2010 and EQE 2009 papers. The papers can be downloaded from the EPO website <http://www.epo-arg/patents/learning/qualifying-examination.html>
They are also available on CD-ROM.
3. Candidates send their paper(s) to the tutor they have been assigned to by the *epi* Secretariat not later than October 18, 2010. The tutor reviews the paper(s).
Candidates who do not get an answer to their papers from their tutor by the due date are requested to contact the *epi* secretariat immediately.
4. In a second round discussions are scheduled for papers A/B and C/D respectively. The papers are discussed in general, particular problems are addressed, individual solutions commented on and questions answered. The format is flexible: it is up to the tutor and the particular group candidates to decide upon a commonly agreeable form for the tutoring session. In case it is decided that a meeting should be held with all candidates, time and place is to be agreed upon by the tutor and the candidates. The candidates provide in this case their own travel expenses as well as the travel expenses of their tutor. Alternatively a telephone conference could be arranged, but as indicated it is up to the tutor/candidates to agree upon a suitable format.
5. After the tutorial all candidates and tutors will be requested to fill out an evaluation form.
6. Fees for the tutorials: 180,- € for non *epi* students
90,- € for *epi* students

CEIPI preparation courses for the EQE 2011

The Centre for International Intellectual Property Studies (CEIPI), more in particular its International Section, offers an extensive programme of courses for preparing candidates for the European qualifying examination (EQE).

For all papers to the EQE 2011 (AB, C and D), the programme starts with „Introductory Courses“ in the early autumn of 2010, in a number of different cities in Europe (Strasbourg, Paris, Göteborg, Milan), so as to set candidates on the path, as early as possible, for preparing themselves for the exam.

The introductory courses are followed by the „Preparatory Seminars“ in November 2010 and January 2011, centrally in Strasbourg, France, which build up on the introductory courses and expand on the issues treated, as well as providing for working on a mock exam under exam conditions, which is then compared with a CEIPI „model solution“.

CEIPI, by its tutors, has developed this programme over recent years and believes it has been successful in providing a large number of candidates (about 400 every

year) with a set of courses adapted to the EQE, increasing their chances of success.

For paper C, which every year appears to be one of the major stumbling blocks of the EQE, this programme is supplemented with two extra courses: a „Special C-Resitter“ course specifically designed for those who have failed the C-paper (more than) once, and a last-minute „Cramming“ Course, one month before the examination, where candidates, once again can sit last year's paper under exam conditions, followed by a discussion of these drafted papers and the CEIPI-model solution the following day, in small groups. This course also provides for answering any last-minute questions regarding paper C. Both these courses are offered only in Strasbourg.

All courses are provided in the three EPO official languages: English, French and German, and are given by a mix of tutors from private practice (*epi*), industry and the EPO.

The program is as follows (more extensive information is contained in OJ EPO 4/2010):

„Introductory Courses“ 2010

Paper	Milan (EN)	Warsaw (EN)	Göteborg (EN)	Paris (FR)	Strasbourg (EN, DE)
AB	8 pm/9.10.	11/12.10.	24 pm/25.09.	24.09.	18.09.
C	10 pm/11.09.	18/19.10.	3 pm./4.09.	25.09.	17.09.
D	1 pm/2.10.	25./26.10.	1pm/2.10.	3./4.09.	15 pm/16.09.

The fee for each one-day course in Paris or Strasbourg is EUR 500. The fee for the one-and-a-half day courses in Strasbourg, Warsaw, Milan and Göteborg is EUR 750 each.

Closing date for enrolment is 5 July 2010.

More information can be obtained from sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

„Preparatory Seminars“ 2010/2011

The AB seminar will be held in Strasbourg, from 15 to 17 (am) November 2010, the C seminar from 17 (pm) to 19 (am) November 2010. Both parts can be booked separately.

The D seminar will be held twice in Strasbourg, from 10 to 14 January 2011 and from 25 to 29 January 2011. All seminars are intended for those who wish to sit the EQE in 2011.

The fee is EUR 1 000 for the five-day courses (ABC or D); for the AB part on its own the fee is EUR 750, for the C Part on its own EUR 600.

Closing date for enrolment is 5 July 2010.

More information can be obtained from gina.killig@ceipi.edu or from the CEIPI website at www.ceipi.edu

The „Special C-Resitter“ course 2010 will be held in Strasbourg on 26 and 27 November 2010.

The course fee is EUR 850. The price includes the „C-Book“, 3rd edition.

Closing date for enrolment is 4 October 2010.

More information can be obtained from sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

The „Cramming“ course 2011 will be held in Strasbourg (EN, DE) on 3 and 4 February 2011 and in Paris (FR) on 5 February 2011.

The fee for the Strasbourg course is EUR 650, for the Paris course EUR 450.

Closing date for enrolment is 5 January 2011.

More information can be obtained from sylvie.kra@ceipi.edu or from the CEIPI website at www.ceipi.edu

8th CEIPI *epi* Course on Patent Litigation in Europe

The programme of the 2010/2011 CEIPI-*epi* Course is available on the *epi* website www.patentepi.com as well as on the CEIPI website www.ceipi.edu

Any question should be put to the *epi* Secretariat info@patentepi.com

Next Board and Council Meetings

Board Meetings

83rd Board meeting on 25 September 2010 in Oslo (NO)

84th Board meeting on 19 March 2011 in Budapest (HU)

Council Meetings

69th Council meeting on 20 November 2010 in Berlin (DE)

70th Council meeting on 23-24 May 2011 in Dublin (IE)

Update of the European Patent Attorneys database

For the attention of all *epi* members.

Kindly note the following contact data of the Legal Division of the EPO:

European Patent Office
Dir. 524
Legal Division
Patent Administration
80298 Munich
Germany

Tel.: +49 (0)89 2399-5283
Fax: +49 (0)89 2399-5148
legaldivision@epo.org
www.epo.org

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. Be aware that the list of professional representatives, kept by the EPO, is the list used by the *epi*. Therefore, to make sure that *epi* mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 5.2.4 of any change in your contact details.

Thank you for your cooperation.

Please visit the new website www.patentepi.com

List of Professional Representatives as at 31.05.2010

by their place of business or employment in the Contracting States

No.	Contr. State	Total Repr.	% of Tot.Repr.
1	AL	0	0,00
2	AT	115	1,20
3	BE	161	1,69
4	BG	72	0,75
5	CH	411	4,30
6	CY	12	0,13
7	CZ	107	1,12
8	DE	3.216	33,66
9	DK	171	1,79
10	EE	29	0,30
11	ES	158	1,65
12	FI	150	1,57
13	FR	845	8,84
14	GB	1.836	19,22
15	GR	27	0,28
16	HR	27	0,28
17	HU	96	1,00
18	IE	58	0,61
19	IS	22	0,23

No.	Contr. State	Total Repr.	% of Tot.Repr.
20	IT	378	3,96
21	LI	14	0,15
22	LT	30	0,31
23	LU	16	0,17
24	LV	21	0,22
25	MC	3	0,03
26	MK	65	0,68
27	MT	7	0,07
28	NL	417	4,36
29	NO	112	1,17
30	PL	358	3,75
31	PT	43	0,45
32	RO	67	0,70
33	SE	287	3,00
34	SI	31	0,32
35	SK	38	0,40
36	SM	51	0,53
37	TR	103	1,08
	Total:	9.554	100,00

Report on CEIPI Conference „Towards a European Patent Court“ held at the European Parliament, Strasbourg, 16–17 April 2010

This was a well-timed conference, aptly titled in that the focus was on the draft proposal for a European Patents Court (EEUPC) to hear patent cases when the European Union EU Patent comes into force. It is worth recalling here that the EEUPC will apply to both patents granted under the EPC (European patents) and under the European Union (EU Patent) regime. Further, Art. 17 of the draft proposal sets up a mediation and arbitration Centre, the seat of which is yet to be decided. This will provide an alternative forum to the court, to assist parties to resolve their differences without recourse to litigation as such.

CEIPI had assembled a high-powered roster of speakers. *epi* was a sponsor together with INPI and the University of Strasbourg. In addition our President, Kim Finnilä was invited to chair Sessions dedicated respect-

ively to the topics of Entry into force, opting out and transitional period, and Representation, while Walter Holzer was the main speaker on the topic of Representation before the EEUPC.

Some 300 delegates attended, a very good turnout reflecting the importance of a European Patent Court to the success of the project of providing an EU-wide patent.

Opening addresses were given by Catherine Trautmann, MEP and former Minister of Culture and Communication, and Alain Beretz, President of the University of Strasbourg.

The main thrust of Madam Trautmann's address, which was carried forward throughout the conference, was that the EU needs an EU patent to foster EU social and economic development, and therefore an EEUPC is

needed to provide for development of an homogeneous EU patent jurisprudence. Indeed she added that the setting up of a European Union patent system must be a priority of political discussion within the EU. She added that after some 35 years of stalemate there was now real hope that progress can be made.

M. Beretz reminded the audience that CEIPI was founded in 1963, and that CEIPI, as part of the University of Strasbourg, had a big role in supporting the daily work of those practising in IP, and that this role is fulfilled by the excellence of its faculty. CEIPI must remain a leading IP research institute in the EU and as such play a leading role in innovation via IP research. He went on to say that CEIPI could also play a major role in training judges for the EEUPC.

The Chairman, M. Le Theule, Director of the Centre for European Studies, Ecole Nationale d'Administration, set the scene in reminding the audience that the European Parliament is now part of the co-decision procedures with the EC.

Dr. Christophe Geiger, Director General of CEIPI then spoke, outlining the history of the project for the granting of an EU patent. The project started in 1973, leading to the Luxembourg Convention of 1975, but this never entered into force as it was not ratified by some Member States. A draft regulation for a (Community) patent was published in 2000, there was political agreement in 2003, but the project failed because of issues such as language. From 2007 all agreed that progress was needed, that the EPO and EU should work together, and that an EU patent without an EEUPC was unthinkable.

There was a need to take account of the EPLA and after further discussion, the European Council of Ministers published on 4 December, 2009, the first draft of its proposal for a single EU patent and EEUPC.

The question of compatibility with EU law was addressed to the ECJ by the Council, their report is expected towards the end of this year. (There will be a public hearing in Luxembourg on 18 May, 2010, to discuss the link between the EEUPC and the ECJ).

Dr. Geiger concluded that the draft agreement provides a good basis on which to go forward, and that CEIPI via this conference and its research would bring together individuals and institutions who have so far contributed to the EU patent project which would provide a new legal article in the European Union.

Among the speakers from the practical side of the debate, Thierry Sueur, Vice President, Air Liquide, and Chairman of the Patents Working Group of Business Europe, said that now was an important time for the EU Patent, but the road is still a long one to travel and we are only at the beginning. He had three messages for the law makers:

1. Focus on the EEUPC, this must work for there to be meaningful EU Patent protection;
2. Always think of EU industries and their interests;
3. Focus on the desired solution, and CEIPI should take the lead in educating and awareness.

A good many of the speakers expressed the view that as the draft EEUPC is directed to the users, there was more chance of achieving a successful conclusion than if the draft was purely concerned with political matters. The proposal is for local, regional and central seats at first instance and a central single Court of Second instance. The Central first instance court would hear direct, i.e. non-counterclaim applications for revocation, but all the courts could hear all possible aspects of a case, namely infringement, validity, proprietorship, compulsory licenses, contracts/licences, etc.

One speaker expressed the view that the proposal was already too narrow in concentrating on patents, rather than EU IP in general.

The Court will have a pool of both legal and technical judges from which to draw, from all over the EU. There were various discussions on how the judges would be selected, an interesting presentation on this being given by epi member, Axel Casalonga, who noted that the pool of judges would comprise full time „legal“ judges and part-time technical judges. In local regional divisions of the Court at first instance, a party can ask for a technical judge to be appointed or the case can be transferred to the Central Division, which has a mandatory technical judge on the panel of three judges appointed to the Central Division.

He concluded that a complex case needed a technical judge on the panel, whether the issue was validity, or infringement, (or both), it being remembered that the divisions at first instance can hear both validity and infringement in the one court, like for example in France and the UK under their respective national court systems.

Another speaker suggested that recruitment to the pool of Judges could be from members of the Boards of Appeal of the EPO even though those members do not adjudicate on infringement matters.

In the following session „Jurisdiction as regards subject matter“, it was observed that the EEUPC does not handle arbitration. In this case, the view was that the EEUPC could suggest to the parties that arbitration might be a sensible option in a particular case – reference to Article 17 (above).

Thomas Jaeger, a researcher at the Max Planck Institute, reminded the audience that the draft EEUPC proposal was modelled on the EC Enforcement Directive of 2004, but there are differences, for example, the enforcement directive is biased towards the right-holder, whereas the EEUPC is more balanced, for example in consideration of removal of an infringing feature from the alleged infringing product. Also the EEUPC looks to find cross-border solutions being a unitary court, but it could not reconcile diverging decisions of the EPO and ECJ.

Another speaker, Michel Abello, a French lawyer, went through the procedure which is designed to provide a decision from the Court in about a year, the decision being handed down within 6 weeks of a hearing which itself should be scheduled for 1+ day(s) (but not running into weeks).

Turning to the next session, „Territorial Jurisdiction and Applicable Law“, Jean-Christophe Galloux, a Professor at University of Paris and President of IPRI said that the draft gave thought to the law applicable, and that the Agreement should have been drafted by experts in international private law.

Another speaker, (Pierre Veron, a lawyer) observed that a patentee can under Article 15 of the draft now chose where an infringement action should be heard, possibly to the detriment of the defendant. It is also to be remembered that a decision on validity will be EU wide. Another speaker, Eskil Waage, lawyer, EC DG Internal Market, asked whether the EEUPC will enhance the perceived trend to centralisation in national courts, and will a Judge of a national court, who is in the pool of Judges, simple change hats when sitting in the EEUPC? Further, where there is little patent litigation in a group of countries, can they set up a regional division, which itself could have several seats within the region?

Keiran Bradley, head of the Legislation Unit of the European Parliament's Legal Service, talking to the link between the EEUPC and the ECJ, said that the new court would have to respect common European law as laid down by the ECJ. In other words, the court would take into account directly applicable EU law while basing its decision on the Agreement setting up the court. He observed too that there are also „missing links“ in that the draft makes no reference to the European Charter, or to Human Rights legislation, both of which could have a bearing on a patent infringement case. He also observed that not all the judges in the pool would necessarily be from within the EU.

Hubert Legal, Director, Legal Service of the Council of the European Union and former Judge of the CFI, noted that the Council of the EU does not have a set position on the subject, and all the Member States agree that the opinion awaited from the ECJ will have a determining influence on the setting up of the EEUPC. He reminded the audience that the General Court, (formerly the CFI), has decided on appeals from OHIM, but that Trade Marks are different from patents so a specialised EEUPC is required for the latter.

On the same topic, Anne-Sophie Lamblin-Gourdin, Associate Professor, University of Nantes, referred to the autonomy and primacy of EU law over national law.

Continuing the theme Hanns Ullrich, Professor Emeritus, visiting Professor, College of Europe, Bruges, mentioned that the EEUPC will be the instrument by which the EU will be able to develop its own patent policy. However, if the court delivers what are perceived „bad“ decisions, litigants might well revert to the EPC and national litigation procedures.

Our President, Kim Finnila, had the honour of chairing the next session, namely „Entering into Force, Opting Out and Transitional Period“. He noted that there will be a transitional period of five years during which patent cases can be tried in the EEUPC or national courts. The possibility of opting out was only possible for patent proprietors or applicants and had to be notified to the

Registrar of the Court up to one month before the end of the transitional period.

Vincenzo Scordamaglia, Honorary General Director of the European Council, observed that the draft agreement was a technical text from the European Council, and as such it was the exclusive responsibility of the European Union. The EU will join the EPC when the European Patent comes into force. Five years after entering into force, contracting parties not in the EU can join the EEUPC if there is unanimous approval. In that sense the EU and the four EFTA countries are bound by the Lugano Convention. As regards consultation it is proposed that the Member States of the EU, NGO's and the member States of the EPC will be consulted. There is no legal basis in the Lisbon Convention to force the Member States of the EU to accede. It is hoped that at least one EFTA country will accede to the Agreement, but if none does so the Agreement will have to be re-negotiated.

Dieter Stauder, lawyer, former Director of the International Section of CEIPI, noted that most patent litigation cases nationally are settled before a Hearing, (95 % in the UK, greater than 50 % in each of France and Germany). The role of Judges is to try to get a result and should assist the parties in trying to find a solution to their differences, and the aim of the parties should be to work with the Judges to achieve this end.

Stefan Luginbühl, lawyer, International Legal Affairs, EPO, noted that during the transitional period of five years an action could be brought before national courts or any other competent authority. If proceedings are however, started before the EEUPC, then they must continue in that Court. The EU has a wish for the EU Patent to enter into force by 2015 so there will be a long lead time which could result in multiple litigation and diverging decisions on the same patent. In addition, forum shopping would probably continue. Moreover, if a party opts out, there is no possibility to opt back in; defendants have no say in the matter if the patentee does opt out. He suggested that opt out should be dispensed with, with a longer transitional period, say up to 10 years.

Jacques Raynard, Professor, University Montpellier, added his voice to the view that IP law is becoming more and more involved with EU law, and that there must be a strong link between the EU Patent and the EEUPC and EU law.

(A speaker from the floor advised the audience that the EU pharmaceutical industry has already made a sectoral request to opt out of the EEUPC).

It was also observed that opt out can be on a patent by patent basis, so a patentee could chose whether or not to opt in or opt out for any particular patent in its portfolio.

The next session, also chaired by Kim Finnila „Representation before the Court“ produced lively presentations from Walter Holzer, *epi* member and former *epi* President, and also co-ordinator of the CEIPI-*epi*, „Course on Patent Litigation in Europe“, and Patrice Vidon, *epi* member and President of CNIPA.

According to the Agreement, parties before the EEUPC can be represented by a lawyer or by a European Patent Attorney holding an EU litigator's certificate. Walter Holzer put forward a strong case for European Patent Attorneys to be able to represent a party before the Court, noting that the EPLA did not limit representation to lawyers and already granted right of audience to European Patent Attorneys. He noted too that European Patent Attorneys also had a technical as well as a legal background, making them well-suited for patent cases.

Article 28 of the Agreement also enables representation by Patent Attorneys having a European Union Litigator's Certificate but does not set out any rules for obtaining it. Walter Holzer then cited the CEIPI/*epi* Course on Patent Litigation in Europe, which has been running successfully for the last seven years and which leads to the granting of a University diploma for successful candidates, suggested that the diploma could be the basis for the EU Litigator's Certificate, and also suggested that CEIPI would be prepared to provide the curriculum for the Certificate to the EU.

Patrice Vidon added that since the Central Division and Appellate Divisions were to have technical Judges, it was only logical that EPA' should have a right of audience as a complement. He urged that the EU should not be afraid of the right of patent attorneys to act as representatives before the EEUPC.

„Language of Proceedings“ had a session to itself. Bertrand Warusfel, Professor, University of Lille2, observed that this was an important question, particularly as there could be a language of the proceedings before the EEUPC which was different from the language of the patent in suit. This could prejudice one of the parties, particularly on appeal, as the language of the second instance would be the language of the first instance proceedings.

Peter Meier-Beck, President and Judge of the Bundesgerichtshof, confirmed that there would be different possible choices of language, depending on the seat of the Court of First Instance, the language of the patent, and the nationality of the parties.

Vincent Cassiers, researcher, Catholic University of Louvain, said that the language regime could deter SME's which would not be in the interests of the EU. SME's must have access to the judicial system and that access should not be prejudiced by having to defend a case in a non-mother tongue, particularly if forum shopping is engaged in by a financially stronger adversary.

Francis Ahner, and *epi* member, mentioned that languages used in the EP patent would be those of the EPO.

The final session was a presentation on „Agenda and Prospects“ given by Margot Froehlinger, Director, EC, DG Internal Market, Direction D: Knowledge-based Economy. She said that she expects that after the oral hearing at the ECJ on the 18th May 2010 that Court will deliver its opinion on the EEUPC which she had a feeling would be favourable, perhaps with some conditions, for example that the EEUPC should not revert to the forum set up under the EPLA.

The draft Agreement is the only way forward, particularly as it will result in the granting of an EU patent. Once the ECJ opinion is received, the EC will commence negotiations. There could well be a diplomatic conference in the second half of 2011. The granting of EU patents and the setting up of the EEUPC would then follow by 2015/2016. In addition to consultations with interested parties the EC will carry out feasibility studies on inter alia training courses, Judges, languages, EU litigator's certificate, translators and interpreters.

The EU litigator's certificate is important for SME's and it is also important that European Patent Attorneys can acquire the certificate and represent clients in the court.

Finally, Ms Froehlinger gave her view that the inception of the EU patent and EEUPC will make an important contribution to European integration.

Following the sessions, a final report on the conference was given by Michel Vivant, Professor, Paris Institute of Political Studies, „Sciences PO“. He thought the conference was a success, concentrating as it did on the practical aspects of the proposed system while covering a rich mixture of topics from language to competence of Judges and Representatives. It also gave constructive suggestions to the legislators as to how the draft Agreement could be progressed.

I hoped the foregoing gives a flavour of the conference which had stellar speakers on all the topics reflecting on the importance of the subject for the development of the European Union. CEIPI is to be congratulated on its foresight and initiative in hosting such a topical meeting, putting it all in place within four and a half months of the Council draft of the 4th December 2009. Where there is a will there is a way!

T. Johnson,
Editorial Committee
Reporter

Filing date requirements under the EPC – an option to extend subject-matter?

C. Mulder (NL)¹ and D. Visser (GB)²

Introduction

The Patent Law Treaty (PLT) entered into force in April 2005. The aim of the PLT is „to harmonise and streamline“, on a world-wide basis, formal procedures relating to national and regional patent applications and maintenance of patents. As the formality requirements for filing a patent application vary from country to country, the PLT aims at simplifying and harmonizing the rules in all participating countries. The PLT does not establish a uniform procedure for all parties to the PLT but leaves parties free to require fewer or more user-friendly requirements than those provided in the PLT.

During the past few years the main features of the Patent Law Treaty have been implemented in the Patent Cooperation Treaty and in the European Patent Convention. Whereas the EPO has implemented all options of the PLT during the EPC 2000 revision, the PCT could only implement a subset of the PLT because the articles of the PCT could not be amended.

Filing date requirements – Article 5 PLT

Article 5 of the PLT³ governs the requirements for the accordance of a date of filing. In particular, Article 5(1) PLT prescribes the elements of an application to be filed for the purpose of according a date of filing. Firstly, the Office receiving the application documents needs to be satisfied that the elements that it has received are intended as an application for a patent. Secondly, the Office must be provided with indications which identify the applicant and/or allow the applicant to be contacted. Instead of such indications, the Office may accept evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office. Thirdly, the Office must have received a disclosure of the invention, either in the form of what appears to be a description or, where permitted, a drawing in place of that description. In addition, Article 5(7) PLT obliges⁴ a Contracting Party to accept, at the time of filing, the replacement of the description and any drawings in an

application by a reference to a previously filed application, subject to certain formal requirements.

A Contracting Party is obliged to accord a date of filing to an application which complies with the requirements of Article 5 PLT. Since the list of elements under Article 5(1) PLT is exhaustive, a PLT Contracting Party is not permitted to require any additional elements for a filing date to be accorded⁵. In particular, it is not permitted to require that the application contains one or more claims, compliance with formal requirements (e.g. that handwritten applications are not accepted), use of a prescribed language, or payment of a filing fee⁶.

Implementation of the PLT in the EPC

Upon revising the European Patent Convention resulting in the so-called EPC 2000⁷, the requirements set by the PLT were implemented into the EPC. Amongst others, the following items were adopted in the Implementing Regulations of the EPC:

- Requirements for according a date of filing to a patent application [Article 5(1) PLT; Rule 40 EPC] including relief with respect to language requirements [Article 5(2)(b) PLT; Article 14(2) EPC implying that an application may be filed in any language];
- Filing a description and/or drawings by a reference to another application [Article 5(7) PLT; Rule 40(1)(c) EPC];
- Filing missing parts of the description or missing drawings [Article 5(6) PLT; Rule 56 EPC];
- Addition or correction of a priority claim [Article 13(1) PLT; Rule 52(2) and (3) EPC];
- Restoration of right to priority [Article 13(2) PLT; Rule 136(1) EPC].

The EPO has chosen for a complete implementation of the PLT in the EPC. In contrast, the PCT has only included a limited set of options of the PLT, because the articles of the PCT could not be changed. In this publication a few peculiarities will be discussed relating to the specific implementation of the PLT into the EPC.

Filing date requirements – Rule 40 EPC 2000

The requirements set out in Article 5 PLT have been incorporated in Rule 40 EPC, implementing Article 80

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3 The Patent Law Treaty was adopted on 1 June 2000 at a Diplomatic Conference in Geneva; the Treaty entered into force on 28 April 2005. See <http://www.wipo.int/treaties/en/ip/plt/>.

4 See the „Explanatory Notes on the PLT and the Regulations under the PLT“ (WIPO Publication 258), Note 5.23.

5 *Ibid.*, Note 5.02.

6 *Ibid.*, Note 5.02.

7 The revised European Patent Convention (EPC 2000) was adopted on 29 November 2000 at a Diplomatic Conference in Munich and entered into force on 13 December 2007; see <http://www.epo.org/patents/law/legal-texts/epc.html>.

EPC (all references to the EPC are to the EPC 2000). Rule 40(1) EPC prescribes that the date of filing of a European patent application is the date on which the documents filed by the applicant contain:

- (a) an indication that a European patent is sought;
- (b) information identifying the applicant or allowing the applicant to be contacted; and
- (c) a description or reference to a previously filed application.

Rule 40(2) and (3) EPC deal with further requirements in the case where the applicant, instead of filing a description, refers to a previously filed application. In particular, Rule 40(2) EPC states that in this case the applicant must state the filing date and number of that application and the Office⁸ with which it was filed, and indicate that the reference replaces the description and any drawings. In addition, Rule 40(3) EPC requires an applicant to file a certified copy of the previously filed application within two months of filing the application. Since Rule 53(2) EPC applies *mutatis mutandis*, the applicant need not file a copy of the previously filed application where this application is already available to the EPO under the conditions specified by the President [see Guidelines⁹ A-II, 4.1.3.1]. Where the previously filed application is not in an official language of the EPO, a translation thereof in one of these languages shall be filed within the same period.

When filing by reference, the date of filing accorded will be the date on which the applicant complies with requirements (a) and (b) and correctly identifies the earlier application [Rule 40(2) EPC]. If the applicant later on furnishes the certified copy of the previously filed application in due time or the previously filed application is in the files of the EPO, *all* requirements for obtaining a filing date are met.

If the applicant does not provide the certified copy of the previously filed application in due time [Rule 40(3) EPC, first sentence] and such copy is not already available to the EPO, the applicant will receive a communication under Rule 55 EPC, requesting him to file the certified copy within a non-extendable period of two months. If he files the certified copy within this period, the application will be re-dated to the date of receipt of the copy. If the applicant does not provide the certified copy in due time, the application will not be treated by the EPO as a European patent application¹⁰. This implies that the filing date which was already accorded upon filing the reference to the previously filed application is taken away retroactively.

The requirement in Rule 40(3) EPC that the applicant must file a translation of the previously filed application, where that application is not in an official language of

the EPO, has no influence on the accordance of the date of filing, in spite of the fact that the requirement is provided in Rule 40 EPC. Hence, if the applicant does not furnish a required translation of the previously filed application, the date of filing already accorded to his application is *not* taken away (retroactively). In the last sentence of Guidelines A-II, 4.1.4, the EPO confirms that: „The filing date is unaffected by a missing translation.“ In the case of a missing translation pursuant Rule 40(3) EPC, the EPO will send the applicant not a communication according to Rule 55 EPC but a communication according to Rule 58 EPC, informing him that the required translation has not been filed and requesting him to file the translation within a non-extendable period of two months¹¹.

As Rule 55 EPC implements Article 90(1) EPC [accordance of a date of filing] and Rule 57 and Rule 58 EPC implement Article 90(3) and Article 90(4) EPC, respectively [examination of formality requirements], the furnishing of a required translation of the previously filed application should not have been included in Rule 40 EPC. The presence of the translation requirement in Rule 40 EPC is confusing, because its title, „Date of filing“, suggests that *all* requirements listed in Rule 40 EPC have to be met in order to meet the requirements for the accordance of a date of filing.

In the opinion of the authors, the requirement in Rule 40(3) EPC that the applicant must file a translation of the previously filed application, where that application is not in an official language of the EPO, should be removed from Rule 40 EPC because it does not belong to the requirements for the accordance of a date of filing, and does not implement Article 80 EPC.

It is proposed to include the translation requirement in Rule 6(1) EPC by adding a reference in the provision to Rule 40(3) EPC, which makes it clear that the provision of the translation is not a filing date requirement. The addition to Rule 6(1) EPC has the further advantage that it is immediately clear that the translation of a previous application filed under Rule 40(3) EPC is a translation under Article 14(2) EPC because of the reference in Rule 6(1) EPC to this article. Without the connection with Article 14(2) EPC, it is not clear whether the translation may be corrected after filing by bringing it into conformity with the application as filed and what the sanction is on not filing the translation (deemed withdrawn). At present, the possibility for correction and the sanction have only a basis in the Guidelines¹². It should be noted that even the Explanatory Notes of the EPO to the Implementing Regulations¹³ regarded the translation requirement in Rule 40(3) EPC to be a *lex specialis*, not related to Article 14(2) EPC, having refusal under Article 90(5) EPC as sanction.

8 Note that, contrary to the wording of Rule 40(2) EPC, the Request-for-Grant form (EPO Form 1001, version 07.09) requires the applicant to fill in the „State“ where the previous application was filed.

see <http://www.epo.org/patents/Grant-procedure/Filing-an-application/European-applications/forms.html>.

9 The Guidelines for Examination in the EPO, version April 2010; see <http://www.epo.org/patents/law/legal-texts/guidelines.html>.

10 *Ibid.*, A-II, 4.1.4.

11 *Ibid.*, A-II, 4.1.4 and A-III, 14.

12 *Ibid.*, A-III, 14: „Failure to file the translation on time in response to the invitation under Rule 58 EPC results in the application being deemed to be withdrawn according to Article 14(2) EPC. The EPO will then notify the applicant of this loss of rights according to Rule 112(1) EPC.“

13 Document CA/PL 17/06 of August 2006. Also see: http://archive.epo.org/epo/pubs/oj007/12_07/special_edition_5_epc_2000_regulations.pdf, p.106.

Filing missing items – Article 5(6) PLT

Article 5(6) PLT obliges¹⁴ a PLT Contracting Party to allow the inclusion, in the application, of a *missing part of the description* or a *missing drawing* that is filed within a prescribed time limit. It applies whether or not the applicant has been notified of a missing item. Normally, the late filing of a missing item causes the filing date to become the date of receipt of the missing item, provided that all of the other requirements for the according of a filing date are complied with on that date [cf. Rule 2(3) PLT].

In particular, Article 5(6)(b) PLT obliges¹⁵ a Contracting Party to allow, upon the request of the applicant, the inclusion of a missing part of the description or of a missing drawing in the application *without loss of the filing date*, where that missing part or missing drawing is „completely contained“ in an earlier application, from which priority is claimed, provided the additional formality requirements are complied with [cf. Rule 2(3) and (4) PLT]. The PLT leaves the question of whether, in a particular case, a missing part of the description or a missing drawing is *completely contained* in the earlier application to the Office to determine on the facts of that case.

The wording of Article 5(6)(b) PLT is very specific with respect to the nature of the earlier application and *by when* that application must be mentioned:

Where the missing part of the description or the missing drawing is filed under subparagraph (a) to rectify its omission from an application which, *at the date on which one or more elements referred to in paragraph (1)(a) were first received by the Office, claims the priority of an earlier application*, the filing date shall, upon the request of the applicant filed within a time limit prescribed in the Regulations, and subject to the requirements prescribed in the Regulations, be the date on which all the requirements applied by the Contracting Party under paragraphs (1) and (2) are complied with.

The italicised part of the above paragraph makes clear that when the applicant desires to make use of the provision of Article 5(6)(b) PLT to incorporate a missing part of the description or a missing drawing into an already filed application without loss of the filing date initially accorded by the Office, the earlier application must not only be a *priority application* but also that the *priority of this earlier application must have been claimed on „the date on which one or more elements“* referred to in Article 1(a) PLT „were first received by the Office“.

Note, that the PCT¹⁶ upon implementing the filing of missing items without loss of the initial filing date [see e.g. PCT Rule 20.6] has taken over, in PCT Rule 4.18, the literal wording of Article 5(6)(b) PLT, stating:

Where the international application, *on the date on which one or more elements referred to in PCT Article 11(1)(iii) were first received by the receiving Office, claims the priority of an earlier application*, the request may contain a statement that, where an element of the international application referred to in PCT Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in PCT Rule 20.5(a) is not otherwise contained in the international application but is completely contained in the earlier application, ...

The PCT does not allow late filing of missing items based on a priority claim added after the date of filing¹⁷.

Filing missing items – Rule 56 EPC 2000

The requirements as set out in the Article 5(6) PLT for filing missing items have been taken over in Rule 56 EPC implementing Article 90 EPC.

After receipt of the application, the EPO will first examine whether the application is entitled to a date of filing. If during this check the EPO notes that parts of the description or that drawings appear to be missing, it will invite the applicant to file the missing items within two months from invitation [Rule 56(1) EPC]. If the applicant does not reply to this invitation in time, all references to the missing items are deemed to be deleted [Rule 56(4)(a) EPC]¹⁸.

According to Rule 56(2) EPC, the applicant may also file missing parts of the description or file missing drawings of his own motion (without being invited to do so by the EPO) within two months of the date of filing. In the (rare) event, that the applicant is invited by the EPO to file the missing item, the 2-month period under Rule 56(1) EPC takes precedence over the 2-month period of Rule 56(2) EPC, the latter period always expiring earlier because it is coupled to the initially accorded filing date. The last sentence of Rule 56(1) EPC stipulates that the applicant may not invoke the omission of a communication from the EPO under Rule 56(1) EPC.

If an applicant files a missing part of the description or a missing drawing of his own motion or upon invitation from the EPO, the normal situation is that the application is re-dated to the date on which the missing item is received by the EPO; the EPO informs the applicant accordingly [Rule 56(2) EPC]¹⁹. If the applicant is „not happy“ with the later filing date, because, e.g., he realises that the re-dating causes him to lose priority from an earlier application, he can retract the effect of the re-dating by withdrawing the missing item(s) within one month from the communication of Rule 56(2) EPC, in which case the re-dating is deemed not to have been made [Rule 56(6) EPC]²⁰.

In paragraph 3 of Rule 56 EPC, the EPO allows an applicant to file missing parts of the description or to file missing drawings (within the prescribed periods) *without*

14 See the „Explanatory Notes on the PLT and the Regulations under the PLT“ (WIPO Publication 258), Note 5.20.

15 *Ibid.*, Note 5.21.

16 On 1 April 2007, the Regulations under the Patent Cooperation Treaty were amended to implement the Patent Law Treaty; for the text of the PCT Regulations as in force since 1 July 2009, see http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct_regs.pdf.

17 See the PCT Applicant's Guide – International Phase, item 6.028, see <http://www.wipo.int/pct/guide/en/gdvol1/pdf/gdvol1.pdf>.

18 Guidelines for Examination in the EPO, version April 2010, A-II, 5.1.

19 *Ibid.*, A-II, 5.3.

20 *Ibid.*, A-III, 3.2.2.

loss of the initial filing date. Of course, a lot of requirements have to be met in order to allow for this; the Guidelines A-II 5.4 summarize the criteria to be satisfied:

- (i) the missing parts are filed within the applicable time limit;
- (ii) the application claims priority;
- (iii) the applicant requests that the late-filed parts be based on the claimed priority in order to avoid a change in the date of filing, and does so within the applicable time limit;
- (iv) the late-filed parts of the description, or drawings, are completely contained in the claimed priority application;
- (v) the applicant files a copy of the priority application within the applicable time limit, unless such copy is already available to the EPO under Rule 53(2) EPC [Rule 56(3)(a) EPC];
- (vi) where the priority document is not in an official language of the EPO, the applicant files a translation into one of these languages within the applicable time limit, unless such a translation is already available to the EPO under Rule 53(3) EPC [Rule 56(3)(b) EPC];
- (vii) the applicant indicates where in the priority document and, if applicable, where in its translation, the late-filed missing parts of the description, or drawings, are completely contained, and does so within the applicable time limit [Rule 56(3)(c) EPC].

The „applicable“ time limit mentioned above is either the 2-month period of Rule 56(1) [invitation from the EPO to file missing items] or the 2-month period of Rule 56(2) EPC [applicant files missing items of his own motion].

If a request according to Rule 56(3) EPC does not comply with one or more of the above requirements (ii)-(iv), the date of filing will change to the date on which the EPO received the late-filed missing items of the application; the EPO informs the applicant accordingly [Rule 56(2) EPC]. If the request according to Rule 56(3) EPC does not comply with one or more of the above requirements (v)-(vii), the date of filing will change to the date on which the EPO received the late-filed missing items of the application; the EPO informs the applicant accordingly [Rule 56(5) EPC]²¹.

The formulation of Rule 56(3) EPC requires that „... the application claims priority of an earlier application ...“ but it does not prescribe *when* such a priority claim must be made. The Guidelines A-II, 5.4.1 specify in this respect:

Where the applicant files a request under Rule 56(3) EPC, the priority claim in question *must have been in existence no later than the filing of this request*. To this end, the applicant can file a simultaneous request, contained in one single submission:

- (i) to insert a new priority claim not present when the application was filed according to Rule 52(2) EPC, and

- (ii) to base late-filed missing parts of the description, or drawings, on that priority claim according to Rule 56(3) EPC.

This is subject to the proviso that the above simultaneous request respects both the time limit according to Rule 52(2) EPC for insertion of a new priority claim and the applicable time limit for making the request according to Rule 56(3) EPC. If this is the case, then the requirement under Rule 56(3) EPC that priority be claimed is met.

From the above, it becomes clear that the Guidelines allow an applicant to add a priority claim after the date of filing and, subsequently or simultaneously, allow him to file missing parts of the description or missing drawings based on this later inserted priority claim. This is a broadening of Article 5(6)(b) PLT, which requires that, upon the incorporation of a missing part of the description or a missing drawing into an already filed application based on a priority application, the priority of this earlier application must have been claimed on the date one or more elements of the application were first received [see the discussion above].

Apart from deviating from a mandatory requirement of the PLT, this „leniency“ in the Guidelines with respect to the later insertion of a priority claim represents a direct violation of Article 123(2) EPC, which provides that the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the *application as filed*. The following two examples will clarify this.

Example 1

An applicant has invented a new method of preparing chemical compounds. He has filed a European patent application EP-A describing and claiming the new method and a new compound obtained by the method. In the priority year, more experiments are carried out and a second, new compound is prepared by the new method. A European patent application EP-B is filed, describing and claiming the second compound. The description of this later application gives a brief account of the method for preparing the second compound.

Shortly after filing EP-B, the applicant realises that EP-B might suffer from insufficiency of disclosure [Article 83 EPC], because the method has not been described in full, the method in EP-A was not published before the filing date of EP-B and the method is not known from the common general knowledge²². Within two months from the filing date of EP-B, the applicant files a passage from the description of EP-A containing the full disclosure of the preparation method as „missing part of the description“ for inclusion into EP-B, at the same time adding to EP-B a priority claim to EP-A. This practice is currently sanctioned by the Guidelines²³.

²¹ *Ibid.*, A-II, 5.4, last paragraph.

²² *Ibid.*, C-IV, 11.2 and 11.3.

²³ *Ibid.*, A-II, 5.4.1.

This way the applicant can add subject-matter to an application after the filing date to remedy an apparent insufficiency of disclosure of the application. As the priority claim to EP-A was not made on the filing date of EP-B, the „application as filed“ had no „knowledge“ of the „intention“ of the applicant to add later on subject-matter to EP-B. This is a direct violation of Article 123(2) EPC, in the opinion of the authors.

Example 2

An applicant has invented multiple solutions for a problem of a known product. As the applicant neither knows yet which solution will eventually be implemented in the products nor what his competitors will do, he files a number of patent applications in order to keep his options open. The applicant files a European patent application (EP1, EP2) for each solution, each application describing and claiming a novel and improved product, implementing one of the solutions, in broad terms with detailed embodiments in the description.

Shortly after filing EP2, the applicant realises that some of the embodiments described in EP1 but not in EP2, are also covered by the claims of EP2. The applicant, within two months from the filing date of EP2, files a passage from the description of EP1 containing the text of the desired extra embodiments as „missing part of the description“ into EP2, at the same time adding to EP2 a priority claim to EP1. Currently, this practice is also sanctioned by Guidelines²⁴. After receiving the search opinion [Rule 137(2) EPC], the applicant can file amended claims incorporating these embodiments as dependent claims in EP2.

As the priority claim to EP1 was not made on the filing date of EP2, the application „as filed“ did not contain the extra embodiments. The later addition of the priority claim and filing missing parts completely contained in the priority application as permitted by Rule 56 EPC, allows the applicant to extend the subject-matter of his application after the filing date, contrary to Article 123(2) EPC.

Conclusion

The Guidelines A-II, 5.4.1 implementing Rule 56(3) EPC allowing an applicant to add a priority claim after the filing date of a European patent application and to file missing parts based on this earlier application, are in conflict with Article 123(2) EPC. It is recommended to change Rule 56(3) EPC to conform to Article 5(6)(b) PLT.

Alternatively, the cited section of the Guidelines should be amended and stipulate that if the applicant desires to file missing items based on a priority application, the priority claim should have been made on the filing date of the application. This would avoid problems with extension of subject-matter with respect to the application „as filed“ [Article 123(2) EPC] and would bring the EPC in line with the requirements of the PLT in respect of filing missing items.

In accordance with the requirements set by the PLT, the PCT requires that the priority claim be present „on the date on which one or more elements referred to in PCT Article 11(1)(iii) were first received by the receiving Office“ if the applicant desires to include missing items without loss of the filing date.

Additional comments on Rule 56 EPC 2000

It should be noted that the application of Rule 56 EPC is not limited to the filing stage of a European patent application. For example, when the Receiving Section has decided not to re-date the application under Rule 56(2) or (5) EPC, but the search examiner is of the opinion that the subsequently filed missing parts are not „completely contained“ in the priority document and/or the requirements of Rule 56(3) EPC are not fulfilled, the search should also take into account prior art which might become relevant for assessing novelty and inventive step of the subject-matter claimed if the application were re-dated pursuant to Rule 56(2) or (5) EPC. If the Examining Division comes to the conclusion that the missing elements are not „completely contained“ in the priority document, contrary to the original finding of the Receiving Section, it will communicate this to the applicant and notify him of the new date of filing. The Examining Division must also inform the applicant that, according to Rule 56(6) EPC, the missing drawings or parts of the description can still be withdrawn within one month from the communication from the Examining Division [note that the Guidelines C-VI, 3.1 incorrectly write „... within two months from the date of notification of the new date of filing.“]. If the applicant opts for withdrawal, the re-dating of the application will be deemed not to have been made.

In addition, the numbering of the paragraphs in Rule 56 EPC is peculiar in that an earlier paragraph (4) refers to a later paragraph (6). It would be more logical to renumber the paragraphs of Rule 56 EPC as follows: (4) to (6), (5) to (4) and (6) to (5).

²⁴ *Ibid.*, A-II, 5.4.1.

The pitfalls in the swamp (How your client could lose the opportunity to protect perfectly patentable inventions)

N. Blokhuis (NL)¹

On 1 April 2010, we have seen quite a number of changes in the Implementing Regulations come into effect. For some of the changes, like the introduction of a time limit for filing divisionals, it has been clear from the onset that they would have a significant impact on daily practice. Other changes, like the mandatory reply to the search opinion, seem less dramatic.

In the months before April this year, I did what I think most serious practitioners did: read through the amended Rules one-by-one, compared them with the „old“ Rules one-by-one, read some articles by colleagues that discussed the amended Rules one-by-one, and pondered over the effects the changes could have on daily practice and on the advice I give my clients.

However, it was not until I was preparing for a meeting with a US attorney who had asked me to explain the upcoming changes that it struck me: with these amendments, the devil is not just in the detail, it is in particular in the combination of details. And with respect to the possibility to file divisionals under R.36(1)(b), the combination of some details could indeed have a devilish effect.

In itself, R.36(1) seems quite straightforward. As long as you have a pending application you can file pretty much any divisional you want until 24 months after the first Communication from the Examining Division in respect of the earliest application for which a Communication has been issued. In that period, it's just like the old days. After that period, you'll need an objection under Art. 82 from the Examining Division. As one of my colleagues put it, then you are in the swamp of R. 36(1)(b).

As we are all probably aware of by now, there are policy-makers within EPO who at least suspect applicants who file divisionals – in particular multiple, cascading divisionals – to be abusers of the system. With the current amendments to the Rules, these policy-makers seem to have provided tools to examiners that can help them to prevent applicants from filing divisionals after the period of R.36(1)(a). Disturbingly, these tools work as well for divisionals containing perfectly patentable inventions as for downright abusive divisionals, and they can be applied just as easily in any case.

In particular the new R.70a, the new R.62a and R.64 can deprive you of the opportunity to file a divisional once the period of R.36(1)(a) has expired. It is not just a swamp you are in once you fall under the regime of R.36(1)(b), you are in a swamp with pitfalls.

The First Pitfall: R.70a – mandatory reply to the Search Opinion

The new R.70a requires the applicant to file a reply to the written opinion that accompanies the European Search Report. At first glance, this has nothing to do with divisionals, but looks can be deceiving.

According to the new R.70a, the EPO will invite the applicant to comment on the search and written opinion and „to correct any deficiencies noted in the opinion accompanying the European Search Report and to amend the description, claims and drawings within the period referred to in Rule 70, paragraph 1“.

The Notices from the EPO and the Guidelines leave no room for doubt: the written opinion accompanying the European Search Report is not to be regarded as a Communication from the Examining Division for the purpose of R.36(1).

On the other hand, the EPO has made it clear that they expect the applicant to deal with this written opinion as if it were a Communication pursuant to Art. 94(3). Rule 70a has been introduced to reduce the time it takes for the EPO to reach a decision on grant or refusal by not having to send the written opinion again as a Communication pursuant to Art. 94(3). Therefore, a thorough reply is expected from the applicant, addressing all issues raised by the search examiner and amending the application where „appropriate“.

Now, imagine a case in which a divisional application was filed near the end of the 24 months period of R.36(1)(a). For this divisional, the representative receives a European Search Report accompanied by a written opinion outside the 24 months period. In the written opinion, the Search Division notes lack of unity under Art. 82. Two distinct inventions, A and B, are identified.

Knowing that a comprehensive reply to the written opinion is now mandatory, the representative in his reply limits the claims to invention A. He plans to protect invention B in a further divisional, as usual. In fact this representative did just what the EPO would expect a „good applicant“ to do. However, it has now become impossible to obtain protection for invention B, no matter how patentable invention B in itself may be.

This is caused by the application being transferred to the Examining Division with the amendments made in reply to the written opinion under R.70a and with any voluntary amendments made under R.137(2). The Examining Division will most likely not revisit the objections made by the Search Division, because that would be

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doing the same work twice and that was exactly what R.70a was devised to prevent.

As a consequence, the Examining Division will only consider the claims directed to invention A. In this stage of the proceedings, the examiner has no reason left to make any objection under Art. 82, because the problem with Art. 82 was already resolved by the representative of the applicant before the case was handed over to Examining Division. With the Examining Division not objecting under Art. 82, there is no triggering of the time limit of R.36(1)(b). As a consequence, there is no possibility any more to obtain protection for invention B.

To make things worse, it is highly questionable whether you can repair this situation once you end up in it. Of course, you can try to re-introduce claims relating to invention B after receiving a Communication pursuant to Art. 94(3) or a Communication pursuant to R.71(3). It is after all searched subject matter.

However, there are serious chances that this re-introduction will be refused under R.137(3), because once the case is handled by the Examining Division „no further amendment may be made without the consent of the Examining Division“. This is because amended R. 137(2) and R.137(3) together say that the *only* opportunity to make voluntary amendments to the claims is with the reply to the written opinion. So, the examiner may plainly refuse to let you re-introduce the claims directed to the second invention B and there is nothing you can do about it.

This pitfall can be avoided in the early stages of the proceedings: should you receive a search report with written opinion outside or near the end of the 24 months period of R. 36(1)(a), correct any deficiency you like in reply to the written opinion and the search report, but do not correct any objection under Art. 82. Leave the non-unity problem in the application until the Examining Division has raised the objection under Art. 82. Examiners will not like this approach, but it is necessary to safeguard the interests of your client or company to at least have the opportunity to get all patentable inventions protected.

I assume that the R.70a-pitfall is not an intended pitfall, but merely a possible scenario that happened to be overlooked when drafting the amendments to the Rules.

The Second Pitfall: R.62a – only one independent claim per category searched

The new R. 62a says that if you have two or more independent claims in the same category and the Search Division is of the opinion that they do not fall under the exceptions of R. 43(2), the Search Division may ask you to select one of them. The selected independent claim will be searched, the other one(s) not. If the Examining Division agrees with the Search Division (which is likely as the Search Division generally is the same person as the Examining Division, only with a different hat on), the applicant will be „invited“ to restrict the claims to the subject matter searched.

Again, imagine a case in which a divisional application was filed near the end of the 24 months period of R.36(1)(a). For this divisional, after the 24 month period of R.36(1)(a), the representative receives an invitation under R.62a(1) to indicate which of the independent claims are to be searched.

The other independent claims remain unsearched, at least for the time being. There is nothing you can do about that, as there is no provision that allows you to discuss this issue with the Search Division. The Search Examiner may listen to you (and still do what he or she likes), but nothing prevents the Search Division from refusing any discussion and referring you to the Examining Division because that is the place where it should be decided whether your independent claims comply with R. 43(2) or not. In the meantime, you have to live with the opinion of the Search Division.

Say that after the search, the request for examination is made for the divisional. The Search Examiner puts on his other hat and now calls himself the primary Examiner of the Examining Division. Then you may try to convince him that he was wrong about your independent claims not complying with R.43(2). This could very well be an uphill struggle. Even if the Examiner is willing to discuss his earlier opinion open mindedly, if he would change his mind the examination procedure will take longer because an additional search needs to be carried out. This is contrary to the objective of the new R.62a and contrary to what the managers at the EPO would like to see. So, even if the examiner is willing to set aside his pride, he may not feel like explaining to his superiors that he needs more time for this particular case. An uphill battle, indeed.

The worst thing is that if you lose this battle, the applicant loses the opportunity to obtain protection for the subject matter of the non-selected independent claims.

R. 62a(2) requires that the subject matter of the application is restricted to the subject matter of the claims that were selected in reply to the invitation under R. 62a(1). Furthermore, the non-selected claims are not searched, which makes that R.137(5) prevents them from being introduced in the application under examination anyway.

As the application under examination cannot provide protection for these non-selected claims, the applicant needs a divisional to get protection for them. Unfortunately, the period of R. 36(1)(a) has already expired, and a new period under R. 36(1)(b) will not be triggered. An objection under R. 43(2) is not an objection under Art. 82 and therefore does not trigger a new 24 months period under R.36(1)(b). Also, as the EPO made very clear in its Notice of 20 August 2009, an objection under R.137(5) is not regarded as an objection under Art. 82 either. Therefore, such an objection does also not trigger a new 24 months period under R.36(1)(b).

Again, there seems no way out once you get this far. The only reliable way to avoid this situation seems to limit the number of independent claims in the same category when you file a divisional. For „earliest applications“ this

seems less urgent, as there you will generally have time to file one or more divisionals under R.36(1)(a). With this in mind, I think the new R.62a will prove a powerful tool for the EPO in forcing applicants to write less complex applications and in preventing the cascading of divisionals.

The new R.62a puts applicants in a far worse position with regard to objections under R. 43(2) than they used to be in under the old regime, before 1 April 2010. Back then, if you failed to convince the Examiner that your independent claims complied with R. 43(2), you still had the opportunity to pursue the non-compliant claims in a divisional. If you run into such a situation now, you may no longer have this opportunity.

A similar situation can occur for a divisional in which the Search Division is of the opinion that no meaningful search can be performed. If the Search Division after the lapse of the 24 month period of R.36(1)(a) invites the applicant to state what subject matter has to be searched, and the applicant limits the scope of the search to a part of the application as filed, there is no way to get protection for the unsearched part of the subject matter any more. So, also the amended R.63 can cause a pitfall.

The Third Pitfall: R.64 – invitation to pay a further search fee

The substance of R.64 has not been changed significantly on 1 April, but nevertheless it provides a useful tool for an examiner who wants to prevent the applicant availing himself of R. 36(1)(b).

Again, imagine a situation in which a divisional application was filed near the end of the 24 months period of R.36(1)(a). The search examiner is of the opinion that the claims of the divisional lack unity. He draws up a partial search report and invites the applicant to pay further search fees for the second and further inventions, all perfectly in line with R. 64(1). Meanwhile, the time limit for R. 36(1)(a) has expired.

As is not unlikely in these turbulent times, the applicant may have no money to spend on the further search fees, or maybe he does not want to spend money on the further inventions just now, so no further search fees are paid. „Cross that bridge when we come to it, we can always file a divisional“. He could not be more wrong...

Even if the claims relating to the second and further inventions are still in the claims set when the application is transferred from the Search Division to the Examining Division, you cannot be sure that the Examining Division objects to the claims set under Art. 82. Within the legal framework of the EPC, the claims directed to the second and further inventions may just as well be rejected under R. 137(5), for relating to unsearched subject matter. As an alternative, the Examining Division could rely on G2/92, which says that the Examining Division can limit the examination to the group of inventions for which a search fee has been paid. Neither of these objections triggers a time limit under R.36(1)(b).

Of course, you could be so lucky to have a cooperative examiner who makes an objection under Art. 82. But if

the examiner chooses to object under R. 137(5) instead or he just does not look at some of your claims because of G2/92, you are lost. Once you are in this stage of the procedure, there is no way to force the examiner to object under Art. 82.

In those cases, you are again stuck with one or more possibly patentable inventions, disclosed in a published patent application, which inventions cannot be protected just because you can no longer file a divisional.

The most certain way of avoiding this situation is again to think ahead, and just pay the further search fees if you want to keep all options open.

The Fourth Pitfall: R.62a, R.64 or both?

It is not an unlikely situation that a claims set that is non-unitary also has multiple independent claims in the same category. The question is what the search examiner would do in such a case: invite the applicant to pay further search fees under R.64(1), or invite the applicant to choose an independent claim to be searched in each claim category under R.62a(1).

The Guidelines have a section that deal exactly with this problem: Part B, Chapter VIII, Paragraph 4.5. At the time of writing this article, only the draft Guidelines were available, and they are not very helpful in answering the question whether R.62a or R.64 should prevail.

In the section of the draft version of the Guidelines referred to above, it is said: „It may be appropriate to raise only the issue of unity of invention and send an invitation under R.64(1)... It may, however, be necessary to apply the procedures under both R. 64(1) ... and R.62a(1)..“ Unfortunately, the draft Guidelines do not explain under which circumstances the first option is appropriate and under which circumstances the second option is necessary.

It appears that the choice of which procedure is followed is entirely left up to the examiner. This implies that the applicant does not know beforehand what will happen and therefore he will have to prepare for the worst.

This means that if you file a divisional close to the expiry of the time limit of R.36(1)(a) that comprises more than one invention, you have to draft your divisional very carefully. You cannot rely on receiving an invitation under R.64(1), paying the further search fee and be fine. As long as the claims set comprises multiple independent claims in the same category, you may be faced with R.62a instead, leaving you trapped in the second pitfall.

The Fifth Pitfall: invoke an objection under Art. 82?

Some of the commentaries I read on the changes of the Rules did not seem to be too worried about R.36(1)(b). They suggested that after the 24 months of R. 36(1)(a) you „just invoke an objection under Art. 82“ and the road to further divisionals is wide open again.

So, I tried to think how I could invoke such an objection, if possible in some elegant way that would

not be regarded as downright abuse by the EPO. After all, you never know if at some point one of your clients will find himself tangled up in a mixture of European patent law and the real world, leaving him in need of a divisional after the 24 months of R. 36(1)(a).

For example, say you are in the prosecution of a divisional application. The application is in the hands of the Examining Division, and the 24 months period of R.36(1)(a) has already expired. What can you do to invoke an objection under Art. 82?

You could, in reply to a Communication pursuant to Art. 94(3), amend the claims set by introducing a new claim based on features of the description. Of course, this claim is non-unitary with the claims that already were in the claims set before.

What would an examiner do in such a case? Of course, he could object to the new claim under Art. 82. But that is not the only alternative he has. Your new claim could be objected to just as easily for being unsearched subject matter under R.137(5). Or just as easily, the examiner could downright refuse to give its consent for entering the new claim in the procedure, because no right to file voluntary amendments exists after replying to the search opinion (amended R. 137(2) together with R.137(3)).

So, the examiner has three alternatives for objecting to your new claim: Art. 82, R.137(5) or R.137(3). There is no guarantee that your new claim will get rejected under Art. 82. If your claim gets rejected under R.137(5) or R.137(3), there is no way you can force the examiner to mention Art. 82 as well. You could of course be so lucky that he examiner chooses to object under Art. 82. However, I would rather not rely on sheer luck for getting protection for my client's inventions.

What if you were still somewhat earlier in the procedure, and you would add your claim when you file the reply to the written opinion? In such a case the examiner can not rely on R. 137(3), but he could still reject the claim as relating to unsearched subject matter under R. 137(5). This leaves you in the same situation.

And what if still earlier in the procedure, on the filing of the divisional, you would deliberately put in a claims set relating to two more inventions? The only way for that to work would be if each invention would be covered by claims in a different category because other-

wise you may be faced with an invitation under R.62a, forcing you to choose one claim per category. As the draft Guidelines indicate, in such a case you are left to the mercy of the examiner as to whether you get an invitation to limit the application to a single independent claim per category under R62a or an invitation to pay further search fees under R.64.

Will it really be this bad?

Of course, currently we do not know how the EPO will implement the amended Rules, and how strict or harsh they will inflict them on the applicants. However, the signs do not seem to be very favourable.

The EPO has political goals, and these Rule changes were drafted in order to help reach these goals. The EPO wants us to draft less complex, more straightforward patent applications that can be processed faster by the EPO. Cascading divisionals should not be necessary, and it smells like abuse if you file them.

With this EPO policy, you can count on examiners being stimulated to help realise the goals of the EPO-policy makers. Internal instructions may be issued, incentives may be devised. Examiners that handle applications in line with the goals of the EPO will somehow get credit for that from their management.

If it were easy to trigger an additional 24 months time limit for filing divisionals under R.36(1)(b), it would still be possible to file an endless cascade of divisionals. This is contrary to the goals set by the policy-makers of the EPO, so I expect that the new and amended Rules will not be explained in a way that allows liberal use of R.36(1)(b). Therefore, I expect that there will be for example some incentive for examiners not to object to a newly introduced claim under Art. 82, but to choose of any of the other available options.

I hope I'm wrong with this observation, and that no applicant will lose the possibility to protect an invention that is in itself perfectly patentable. The future will tell how it all works out. Meanwhile, let us all be warned of the risks that our clients and companies run in the swamp of R.36(1)(b).

Mission impossible

No reliable system for monitoring the new time limits for filing divisionals without indication of these time limits in examination reports

H. Wegner (DE) and R. Teschemacher (DE)¹

- I.1. For any party to judicial or administrative proceedings, it is common knowledge that time limits have to be kept and that missing a time limit may be prejudicial to the rights of the party. Any attorney knows that he has to properly assure that time limits are observed. In particular, this is true for grant proceedings before the EPO: In many situations non-observance leads to a loss of right by way of legal fiction. Such fictions allow the EPO to terminate the proceedings in the most efficient way if the applicant ceases to be active. In the past changes in the administrative practice of the EPO and the legislation were always aimed at reducing the danger of a loss of rights, in particular the loss of the application, if a time limit was unintentionally missed. This concept was still valid when the Convention was revised by the EPC 2000 which, for example, substantially extended the availability of further processing as a simple means of redress.
2. However, since the amendments to the Implementing Regulations, applicable from April 1, 2010, entered into force, legal security no longer appears to be a primary goal of the EPO. The amendments restrict the applicant's right to divide the application to an extent hardly known elsewhere (see AIPPI Yearbook 2007/I, Summary Report on Question 193, Section I.5). As will be explained below, this severe worsening of the applicant's procedural situation is further aggravated by the fact that the new time limits cannot be monitored in a standard monitoring system.
- II. The relevant case law has developed a number of principles how a reliable system for monitoring time limits has to be organised:

Time limits foreseen in the EPC are mostly routine time limits. Monitoring such time limits is entrusted to clerical staff especially trained for this task. An involvement of the attorney in individual files is only necessary in unusual cases not covered by appropriate general instructions.

A suitable docket system is an essential element of a monitoring system, in the past often in the form of paper calendars, nowadays more and more as suitable software. In the docket system it has to be noted whether an open time limit has been properly dealt with. Entering of the time limit is done at the earliest possible time, typically when a

document triggering the time limit is received. Entering the time limit at a later stage is a serious source of error since it involves the risk of misdirection or loss of the document. For this reason, entering of the time limit is separate from dealing with it in substance. Rather, it has to be done before.

Monitoring time limits in this way is only possible if it is apparent from the document itself that it triggers a time limit. For example, information on available means of redress or on ensuing legal consequences of an omission to reply serves this purpose.

- III. It is evident that the time limits pursuant to Rule 36 EPC as amended cannot be monitored in a conventional system as outlined above.
 1. Pursuant to Rule 36(1) a) EPC, the time limit for the voluntary filing of a divisional application is triggered by *the Examining Division's first communication in respect of the earliest application for which a communication has been issued*.

However, a communication from the Examining Division does not indicate whether it is the first communication. Nor does it indicate whether the respective application is the parent application for one or several divisional applications. In addition, the term „earliest application“ is open to interpretation and has to be interpreted, a problem which has already been discussed to some extent in literature. Even the Guidelines for Examination as revised for the entry into force of the new rules do not give unambiguous and reliable guidance.
 2. Pursuant to Rule 36(1)b) EPC, the time limit for the obligatory filing of a divisional application is triggered by *any communication by which the Examining Division has objected that the earlier application (i. e. the application to be divided) does not meet the requirements of Article 82 EPC, provided it was raising that specific objection for the first time*.

In this respect, the term „earlier application“, as understood by the EPO, cannot be taken from the provision since an objection to non-unity raised not in the earlier but in a preceding earliest application is alleged to trigger the time limit. However, the specific objection to non-unity in respect of the earlier application can only be raised in the earlier application but not in a preceding application.

Furthermore, it can be quite doubtful whether or not, and if yes, when an objection to non-unity has been raised. Experience shows that the question of

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non-unity is often addressed in a quite vague manner, in addition to clear and substantiated objections. For monitoring the time limit under Rule 36(1)b) EPC, the communication has to be interpreted by the responsible clerical staff which otherwise does not have to be acquainted with unity problems.

3. Two conclusions can be drawn from the above: Monitoring time limits for filing divisional applications is not possible without having the respective file with the history of the case available. This requires a substantial additional effort and implies additional risks for the reliability of the system: The more steps are needed before noting the time limit, the more sources of errors and mistakes exist.

In addition, noting of the time limit is not possible on the basis of the relevant provisions since these are not self-explanatory, at least not in the interpretation suggested by the EPO. This asks too much even of staff well trained for and specialised in monitoring time limits.

These factors have the consequence that time limits for filing divisional applications cannot be treated as usual routine time limits. According to the EPO, 5 % of European applications are divisional applications which amount to some 3000 divisional applications per year.² It goes without saying that an applicant does not yet know at the beginning of the proceedings whether it will be necessary to file a divisional application later on. However, the respective time limits are triggered at the start or at an early stage of the proceedings. In order to be sure that a divisional application may still be filed if the need arises, the applicant or his representative has to check each incoming examination report for a decision whether or not it has to be entered into a system for monitoring the time limits under Rule 36 EPC. There are no figures known as to how many examination reports are issued by the EPO each year. Taking some 100.000 examinations concluded per year, a figure of 150.000 reports may be not too high. This means that statistically some 50 actions for monitoring time limits are necessary in order to file one single divisional application in due time. The necessary checks may involve several files if there is a family of one parent application and one or several divisional applications. At least for the foreseeable future, the checks have to be done on an uncertain legal basis, a fact which forces the applicant or his representative to act on the basis most disadvantageous for him in order to be on the safe side.

As a result a tremendous monitoring effort has become necessary, however without giving legal certainty to the applicant.

- IV.1. Taking all this into consideration, it is astonishing that the EPO has declared not to be in a position to

give the applicant even the most simple administrative support, i.e. to indicate the fact that an examination report is the first examination report. This is all the more surprising as the first examination report was in the past one of the most important criteria to assess examiner productivity. Hence, it had to be available in the EPO's data base. The cover sheet of the examination reports is produced by electronic data processing system of the EPO. Thus, it can be generated with any given text on it. It is hardly conceivable which difficulties prevent the EPO from indicating that a communication is the first communication in the application. This attitude can only be explained by the assumption that either the EPO does not recognise the difficulties arising for applicants or it is not willing to take them into account.

2. For legal reasons, it would be even more important to indicate an objection to non-unity on the cover sheet. It should be clear for the EPO itself and for the applicant, whether and when such an objection has been raised. In cases of doubt, it is neither just nor reasonable to burden the applicant with the risk to find the correct interpretation whether or not non-unity has been objected to. Nor is it an appropriate task for the Receiving Section to decide this question in the course of the examination on filing a divisional application. Rather, it is the examiner himself who should know what he does and should make clear beyond doubt what he does. Under the new regime, an objection to non-unity is an important procedural fact and should also be encoded in the EPO's data base.
3. Moreover, considering the existing problems in interpreting Rule 36 EPC, it is not sufficient to mark a first examination report and to expressly indicate an objection to non-unity on the cover sheet in order to give the applicant legal certainty. In addition, the applicant should be informed about all related applications, i.e. earlier divisional applications, in which the EPO intends to apply the respective time limit. The necessary data on copending earlier and divisional applications are available in the EPO's data base.
- V. In summary it has to be stated that the applicants are only in a position to establish a reliable system for monitoring the time limits for filing divisional applications if the following indications are given on the cover sheet of an examination report and if the applicants' confidence in the correctness and completeness of these indications is protected:
 - which time limit (for voluntary or obligatory division) is triggered, and
 - to which further applications the time limit applies.

² The figure is based on the assumption that the 5 %, cited by the EPO, is related to applications not filed as Euro-PCT applications since the latter cannot be filed as divisional applications.

Communication under Rule 70(2) EPC

T. Powell (GB)

I write to alert Members to the apparent effect of a communication under Rule 70(2) EPC requiring a statement of the applicant's desire to continue a European patent application, following recent changes to Rules 161 and 162 EPC.

Our firm recently received, in a pending European patent application derived from a PCT case on which the EPO was not the ISA, a Rule 70(2) communication that adopted the conventional format. To the casual reader therefore the only action needed in response to this communication was to confirm the applicant's wish that the application should continue.

Rules 161 and 162 however mean that in addition it is necessary to respond to the search opinion forming part of the extended European search report (that in the case in question had issued in mid-April 2010, ie. after new Rules 161 and 162 came into effect).

Failure to file such a response with the indication of the desire to proceed would have led to deemed withdrawal of the application. This effect however is not

mentioned in the current wording of the Rule 70(2) communication.

Our firm contacted the EPO. Staff at that office initially indicated that the only action required in response to the Rule 70(2) letter was to indicate the applicant's desire to proceed. When pressed, however, the EPO staff member confirmed that it is additionally necessary to respond to the search opinion.

It seems the only explicit clue to the requirement to treat the Rule 70(2) letter in this way lies in the fact that the EPO has adopted a new coding, for such letters, in the EPOLine register entries for the cases in question. These now identify the Rule 70(2) letter as an „*Invitation to declare maintenance of the application and to correct deficiencies in the written opinion/amend application*“ (our emphasis).

All practitioners should be aware that the EPO for the time being at least is sending out an incomplete communication, failure to respond fully to which could have dramatically adverse consequences for applicants.

Nichttechnische Anspruchsmerkmale

G. Brose (DE)

Eine Vorbemerkung zur Sprache vorweg: Auch wenn die Mehrzahl der Leser hier die englische Sprache bevorzugt, möchte ich mich doch aus drei Gründen der deutschen Sprache bedienen: Zunächst ist die Verfahrenssprache der Anmeldung, mit der ich mich beschäftigen möchte, die deutsche Sprache. Zweitens möchte ich zwei Entscheidungen unseres deutschen Bundesgerichtshofs zitieren. Und drittens kann ich mich eben in Deutsch immer noch am besten ausdrücken, sodass wenigstens die deutschsprachigen Leser mir jedenfalls sprachlich folgen können. Außerdem sind wir stolz auf die diplomatische Meisterleistung, eine funktionierende europäische Organisation erreicht zu haben, bei der nur drei Sprachen vorgesehen sind. Und diese drei sollten wir auch nützen.

Es ist mir nun zum zweiten Mal gelungen, eine grundlegende Frage so aufzubereiten, dass sie einer Beschwerdekammer vorgelegt werden kann. Im ersten Fall (95107237.0) ging es um die Frage der nebeneinander zulässigen unabhängigen Sachansprüche; allerdings ist

dann nach Jahren die Prüfungsabteilung eingeknickt (nachdem wegen anderer, grober, Verfahrensmängel zurückverwiesen worden war).

Diesmal, im Fall 98440204.0, musste ich aus wirtschaftlichen Gründen schließen. Deshalb möchte ich die zugrundeliegende Frage wenigstens mal hier zur Diskussion stellen. Es geht dabei um die Frage nichttechnischer Anspruchsmerkmale, konkret darum, ob die Prüfungsabteilung verlangen kann, in einen *Sachanspruch* ein *nichttechnisches Verfahrensmerkmal* aufzunehmen. (Im konkreten Fall habe ich dieses Merkmal schon geerbt und habe es gestrichen, woraufhin allein aus diesem Grund zurückgewiesen wurde.)

Den Sachverhalt fasse ich am besten zusammen, indem ich meine letzte Eingabe zitiere, in der ich auch schon im Hinblick auf ein Beschwerdeverfahren den Sachverhalt wie folgt zusammengefasst habe:

„*Es mag zwar sein, dass die manuelle Eingabe des aktuellen Kilometerstands, wie im Anhang zur Ladung genannt, für die Funktion der Erfindung wesentlich ist.*

Die Funktion ist aber nicht beansprucht, sondern nur eine Sache, die entsprechend funktionieren kann. Auch die angesprochene Aufgabenstellung fordert eine Sache, die in bestimmter Weise funktionieren kann. Dafür, dass für die Definition einer Sache im Anspruch eine Funktion, also ein Verfahrensmerkmal, anzugeben ist, ist im EPÜ keine Basis zu finden.

Aber auch soweit die Funktion betroffen ist, ist die Bedeutung dessen, was eingegeben wird, im konkreten Fall die Tatsache, dass eine manuell eingegebene Ziffernfolge den aktuellen Kilometerstand bedeutet, kein technisches Merkmal. Die Bedeutung ist auch kein Merkmal, das an der beanspruchten Sache oder in einem etwa beanspruchten Verfahren abgelesen werden könnte. Die Bedeutung spielt sich vielmehr im Kopf des Benutzers, in der Bedienungsanleitung oder auf andere Weise außerhalb der Erfindung ab.

Nur nebenbei soll bemerkt werden, dass der Unterzeichner sich grundsätzlich kein nichttechnisches Merkmal vorstellen kann, das tatsächlich am Produkt auftritt und sich nicht nur im Kopf des Benutzers, in der Bedienungsanleitung oder auf andere Weise außerhalb der Erfindung abspielt. Ein Anspruch, der ein solches Merkmal enthält, ist dann auch nicht geeignet, durchgesetzt werden zu können, weil nicht wird nachgewiesen werden können, dass er erfüllt ist.

Im konkreten Fall, wo eine manuelle Dateneingabe den aktuellen Kilometerstand des Fahrzeugs umfassen soll, müsste demnach nach der Herstellung in der Endabnahme seitens des Herstellers in einer Testprozedur geprüft werden, ob eine im Rahmen dieser Endabnahme eingegebene Ziffernfolge tatsächlich „den aktuellen Kilometerstand des Fahrzeugs umfasst“, was mangels eines real vorhandenen Fahrzeugs schon gar nicht möglich ist. Wenn die Spezifikation mit dem übereinstimmt, was der Patentanspruch als Gegenstand bezeichnet, dann wird in einem solchen Fall die Einhaltung der Spezifikation überhaupt nicht geprüft werden können. Ein solches Verständnis von Patentansprüchen wäre kommerziell sinnlos; und ein Patent ist ein kommerzielles Instrument, bei dem die Technik und das Recht nur Mittel sind, um das Patent zu erhalten.“

Dazu ist auch noch zu bemerken, dass in einer internen Diskussion mit jungen Kollegen sich keiner ein nichttechnisches Merkmal vorstellen konnte, das tatsächlich an einem Produkt auftritt. Und wenn ein Verfahrensmerkmal in einem Sachanspruch erscheint, so

wird dies zu Recht immer bemängelt. Ein nichttechnisches Verfahrensmerkmal in einem Sachanspruch kann nicht zulässig sein und darf erst recht nicht vom Prüfer gefordert werden. Auch wird ein solches Merkmal nie am Produkt erkennbar sein.

Etwas anders liegt der Sachverhalt in einem Beispielfall, der beim Deutschen Bundesgerichtshof (BGH) unter dem Stichwort „Optische Wellenleiter“ entschieden wurde (X ZB 16/82, BIPMZ 6/1984, S. 211-213). Auch dort war mit dem Merkmal „höchste Modenform der fortzupflanzenden Wellenform“ ein Merkmal beansprucht, das so am Produkt nicht erkennbar war. Dieses Merkmal gab an, für welchen Anwendungsfall das Produkt dann verwendbar war; es war aber auf jeden Fall für irgendeine in Frage kommende „Wellenform“ verwendbar. Und vor Allem: die Abmessungen und die Verwendung müssen zueinander passen.

Eine andere Frage in diesem Zusammenhang ist auch die Frage, ob Merkmale zugelassen werden dürfen, die am geschützten Gegenstand überhaupt nicht auftreten können; als Voraussetzung für die Erteilung gefordert werden dürfen sie auf keinen Fall! Hierzu bemerkt der BGH in der Entscheidung „Doppelachsaggregat“ (GRUR 3/1980, S. 166-169) etwas süffisant unter Punkt II.1.: „Die Bemessung des Schutzzumfangs ... ist Sache des Verletzungsrichters.“ Bei diesem Verfahren ging es um zwei voneinander unabhängige Erfindungen, von denen die erste als nicht ausführbar erkannt und die zweite nur in Abhängigkeit von der ersten beansprucht war. Hier liegt ein vergleichbarer Sachverhalt vor wie bei Europa das Problem der unentrinnbaren Falle nach Art. 123 (2) und (3). (Anmerkung: Es wird immer behauptet, der BGH habe sich zu dieser Frage nie geäußert. Außer in dieser Entscheidung wurde auch noch in „Aufhänger“ hierzu Stellung genommen. Ich selbst habe in einer anderen mündlichen Verhandlung den damaligen Beisitzer und späteren Vorsitzenden Bruchhausen unter dem Vorsitz von Ballhaus unwidersprochen die Bemerkung machen hören (sinngemäß): „Die Merkmale bleiben drin; sie werden bei der Frage der Patentfähigkeit nicht berücksichtigt.“ In diesem Fall war das fragliche Merkmal nachträglich dazugekommen, ohne dass ein Widerspruch oder sonstiger Unsinn entstanden wäre. Dies war (und ist wohl noch heute) die Gerichtspraxis des BGH.)

Ich denke, über diese Fragen sollte mal nachgedacht werden.

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